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MERCK AND CO., INC
P O BOX 2000
RAHWAY NJ 07065-0907

In re Application of	:	DECISION ON
ARRUDA et al	:	
Int. Application: PCT/US2005/044294	:	
Application No.: 11/792,121	:	REQUEST UNDER
Int. Filing Date: 09 December 2005	:	
Priority Date: 15 December 2004	:	
Attorney's Docket No.: 21787YP	:	
For: INHIBITORS OF AKT ACTIVITY	:	37 CFR 1.497(d)

This is a decision on petitioner's "TRANSMITTAL LETTER" filed on 06 March 2008, which is being treated as a request under 37 CFR 1.497(d) to add joint inventor Mark T. Bilodeau and Peter J. Manley in the executed declaration. A petition fee of \$130.00 as been charged to petitioner's Deposit Account No. 13-2755 as authorized in the petition.

BACKGROUND

On 09 December 2005, applicants filed international application No. PCT/US2005/044294 and claiming a priority date of 15 December 2004.

On 31 May 2007, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter was, inter alia, the requisite basic national fee, and an executed declaration was submitted at such time.

On 06 March 2008, applicants filed, inter alia, a request under 37 CFR 1.497(d) and an executed declaration that added Mark T. Bilodeau and Peter J. Manley as co-inventors, who were not listed in the international application.

DISCUSSION

A submission under 37 CFR 1.497(d) must include:

- (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (2) the fee set forth in § 1.17(I); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 CFR §3.73(b) of this chapter).

A review of the application file reveals that applicants have satisfied items (1) - (2) under 37 CFR 1.497(d), but not item (3).

With respect to item (1), the statements submitted on 06 March 2008 by Mark T. Bilodeau and Peter J. Manley are sufficient because the statements state that the error in inventorship occurred without a deceptive intent.

With respect to item (2), the processing fee of \$130.00 has been charged to the Deposit Account No.: 13-2755.

With respect to item (3), Merck & Co., the assignee, consents to the correction of inventorship to the above application. However, there is no copy of the executed assignment to the assignee in the file. To establish the right of the Assignee to take action, applicants must submit a copy of the executed assignment or specify the reel and frame number. Note MPEP 324 and 37 CFR 3.73(b).

Accordingly, the request does not meet the requirements under 37 CFR 1.497(d).

CONCLUSION

For the reasons above, the request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Rafael Bacares

PCT Legal Examiner

PCT Legal Administrative Office

Telephone: (571) 272-3276

Facsimile: (571) 273-0459